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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,212

Applicant(s)

WAMPRECHT ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6 and 8-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/23/05 has been entered.

The amendments of 8/23/05 have been entered. Claims 1-6 and 8-12 are pending.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4079028 Emmons et al..

Emmons discloses a polyurethane thickener which is the reaction product of diisocyanate, polyether polyol having 3 or more OH groups, monoalcohol and monoamine. Upon reaction with the diisocyanate, the polyetherpolyol will have 4 or more OH groups where it began with 3 OH groups and will possess urethane groups in an intermediate product which will necessarily occur as predicted by statistics involved in such reactions of large numbers of molecules, as would be readily understood by the ordinary skilled artisan as such chemical statistics are taught in undergraduate school. It is emphasized that this relates to the intermediate in which one molecule of diisocyanate has reacted to connect two molecules of polyol. It is understood that the reaction will proceed further to give the final polyurethane, which may or may not have any free OH groups. Since the instant claims are directed to the final polyurethane per se and the method of making it, it is enough that the final product have moieties which could be attributed

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to the instantly claimed components of component A and that such intermediates form. The applicant provides no probative evidence that such intermediates do not form. The PTO has no facilities to make such determinations and it is axiomatic that the onus is on the applicant to provide such evidence. The polyurethane need not be made from the reactants of the instant claims because the instant claims are directed to the polyurethane final product and the method of making it. It is not possible to distinguish the polyurethane of the instant claims and the polyurethane of the prior art based on the ingredients which initially formed the polyurethane segment. In other words, making the polyurethane thickener from only the instantly claimed polyether a1 will necessarily give moieties falling within the scope of both a1 and a2 upon reaction of 2 or more molecules of polyether polyol with diisocyanate. Such intermediate reaction will necessarily occur statistically and gives the components of the instant method claims. It is also expected that the patentee's reaction of diisocyanate with the polyether polyol will give a mixture falling within the scope of the instant claim 8, step A, at least as an intermediate of the reaction of Emmons. This again is expected from statistical analysis of the reaction occurring in Emmons. Emmons discloses the combination of monols and amines at column 9, lines 46-68 and column 10, lines 1-19. The degree of picking and choosing required to arrive at the instantly claimed invention is sufficient to remove this reference from the scope of an anticipating reference under the relevant caselaw, such as but not limited to *In re Baird*. See column 2, lines 59-68; column 3, lines 1-68, particularly 31-61; column 4, lines 1-5; column 6, lines 1-68; column 8, lines 1-23 and 48-68; column 9, lines 46-68; and the remainder of the document, particularly the examples. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combination of ingredients to form the thickener of the patentee because the patentee clearly encompasses such mixtures of reactants and the instantly claimed combination of ingredients would have been expected to give the thickening properties discussed by the patentee.

The smaller amount of picking and choosing in the prior art is deemed by the examiner to lead to the choice of the instantly claimed reactant combinations discussed above. Thus, the motivation to combine the reactants taught by one single reference to be useful together and selected from a rather small pool of reactants is deemed to make the instant claims obvious over the cited prior art for the reasons stated above. The applicant's arguments in this regard are therefore not persuasive. It is not seen that the polyurethane thickeners would not necessarily have a softening temperature falling within the scope of that of the instant claims and the instantly claimed softening temperature is typically expected of such polyether based polyurethane thickeners of the molecular weights encompassed by the patentee. It is noted that the method of measuring the instantly claimed softening point is not specified and such methods of measuring polymer softening points lead to different values. There is no probative evidence that the instantly claimed reactants do not give the polyurethane argued above nor that they give any unexpected results. The instantly claimed softening temperature is not seen as giving any unexpected results.

Applicant's argument "On the other hand, in the present invention a slight excess of isocyanate is always used, which is eliminated at the end of the preparation (see the examples in the specification). is not persuasive since the instant claims do not require elimination of the excess NCO at the end of the preparation and the instant claims encompass the use of a vast excess of OH to NCO at the start, presumably of the reaction, at 0.5:1 NCO:OH, which contradicts the applicant's arguments regarding an excess of NCO always being required, as well as the stoichiometric amount of NCO:OH, i.e. 1:1 NCO:OH of the prior art. This argument is therefore not born out by the applicant's own claims and does not distinguish the product of the instant claims over that of the patentee. Column 8, lines 61-62 is isophorone diisocyanate which contradicts the applicant's arguments that Emmons does not disclose IPDI. This list of isocyanates is not so large that the ordinary skilled artisan would not readily use this most

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popular of diisocyanates in the reaction product of the patentee. The applicant's argument re isophorone diisocyanate is therefore not persuasive. This list of isocyanates is not "every possible moiety". It is a few well known very often used urethane forming monomers. No unexpected results are seen in a manner commensurate in scope with the instant claims and the cited prior art stemming from the use of isophorone diisocyanate, including the alleged positive rheological properties argued by the applicant's representative. The instantly claimed polyurethane is not seen to be distinct from that of the prior art based on the use of the reactants of the instantly claimed component A.

Applicants request authority for the assertion that Emmons' polyurethane discussed above necessarily contains moieties having the instantly claimed combinations of polyols of the instantly claimed component A. The applicant's representative is noticed that the instant claims are directed to the polyurethane per se. The polyurethane of Emmons may have a molecular weight of up to 200000 per column 2, lines 56-58. This polyurethane will contain several units of the patentee's polyether polyols which must have "at least 3 OH groups" which are connected by diisocyanates. The applicant's representative is to consider the reaction product of one molecule of diisocyanate with two molecules of polyether polyol having at least three OH groups. The final reaction product will be a polyol having 4 OH groups and 2 urethane groups. This moiety will be present in the polyurethane of Emmons several times and falls within the scope of the instantly claimed component a2) clearly. The other polyether polyols of Emmons having at least 3 OH groups will also be present repeatedly in the polyurethane of Emmons of higher molecular weights and clearly falls within the scope of the instantly claimed component a1). This was clearly described above. Since the polyurethane final product is claimed in the instant claims, not the process of making it, and the polyurethane of Emmons has the moities required by the instantly claimed component A, as clearly described above and more clearly described now, Emmons' polyurethane falls within the scope of the polyurethanes of the instant

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claims regarding the instantly claimed component A. This should be readily clear to the applicant's representative based on the rudiments of polyurethane reactions of polyols and polyisocyanates and should require no further authority as it is clear on its face. The examiner also notes that at least 3 OH groups encompasses 4 OH groups and such compounds reacted with the diisocyanate of Emmons will have 6 OH groups in the moiety present in the polyurethane of Emmons by the thought experiment described above.

The applicant's argument that "Surely the reaction of two or more isocyanate groups in the polyisocyanates used in Marz or Emmons can react with two or more hydroxyl groups on the same polyol. This is true. But the instant claims are to a polyurethane and the polyurethane of Emmons or Marz will necessarily contain the moieties implied by the components of the instantly claimed component A, as clearly illustrated above. The examiner does not have to illustrate that any pathway is more favorable than another in making the final polyurethane because the instant claims do not have enough limitations to imply a final product by which any particular pathway is favored and the polyurethane of Emmons or Marz will clearly have the moieties implied by the instantly claimed component A. The applicant can draw out all of the possible polyurethanes which can result from the high molecular weight polyurethane of Emmons using the ingredients of Emmons and will see that he can in fact excise the moieties which would have resulted from the instantly claimed component A.

The applicant questions whether the instantly claimed obviousness rationale is in Emmons and requests that the examiner cite another reference to support his position on Emmons. No other reference is needed. The motivation and teachings requisite for obviousness are clearly in Emmons on its face, more so now that the applicant's representative is expected to more clearly see how the polyurethane of Emmons will necessarily contain the moieties implied by the instantly claimed component A. No affidavit is required for the above reasons also. This rejection is therefore maintained.

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The applicant's arguments that Emmons does not disclose IPDI is not persuasive for the reasons stated above, particularly note column 8, lines 61-62 which is IPDI. The Sauer declaration is not commensurate in scope with the instant claims and the cited prior art and is therefore not persuasive. The instant claims and the cited prior art do not require the IPDA. It is noted that the declared properties are a function of numerous parameters of the recited reactants, such as HLB, viscosity average molecular weight, identity of associative moieties and amounts thereof, etc. It is not seen that the declarant's examples consider all of the potential differences in these parameters which may be responsible for the declared results. Since the claims encompass broad values of these parameters, as does the patentee, the declarant's examples are not commensurate in scope with the patentee's disclosure and the instant claims.

The applicant continues to state that IPDI is not taught. The applicant's representative is again referred to column 8, lines 61-62 which is IPDI. The argued standards of a prima facie case of obviousness have been well met above. No probative evidence to the contrary is seen. It is not seen that the newly recited limitations regarding component A are not inherent in the above argued polyurethane. The instant claims containing the newly presented limitation regarding the production of component A are directed to the polyurethane per se, not its method of production. It is not seen that the above discussed polyurethane of the patentee does not necessarily and inherently possess the moieties implied by the new product by process of making component A. Such moieties would be expected in the above discussed polyurethane necessarily purely from statistical considerations of the reactions of 10^{23} molecules. No probative evidence is seen to the contrary that the polyurethane of the patentee discussed above does not fall within the scope of that of the instant claims. The argument that a different process is disclosed in Emmons than in the instant claims is not relevant regarding the instant polyurethane claims and composition claims since the polyurethane of Emmons would appear to be that of the instant claims where IPDI of column 8, lines 61-62 is used. Regarding the instant process claims, it is

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not seen that the reaction of Emmons discussed above does not meet the instant method claims. The expectation of success in Emmons is that they make polyurethanes. It is not seen where this leads to an absence of expectation of success. It is not even seen where the instant invention establishes any "success" nor, more importantly to patentability considerations, any unexpected results over that of Emmons in a manner commensurate in scope with the instant claims and the cited prior art.

This rejection is maintained for these reasons and the reasons cited above.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-6 and 8-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/091960 and claims 1-12 of copending application serial number 10/092077. Although the conflicting claims are not identical, they are not patentably distinct from each other

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because, although the claims differ somewhat in scope, they overlap such that it would have been obvious to the ordinary skilled artisan at the time of the instant invention to perform the instantly claimed invention from the claims of the copending application because most of the copending claims' invention is that of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Applicant's disagreement with this rejection is noted but the applicant does not specify any deficiencies in this rejection. It is therefore maintained. No arguments have been applied to this rejection. There is no process for holding this rejection in abeyance and it is maintained for the above reasons.

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,


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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
Art Unit 1714